

**REMARKS:**

Claims 1-31 are currently pending in the application.

Claims 32-50 have been previously canceled without *prejudice*.

Claims 1-31 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1, 4-6, 9-11, 14-16, 19-21, 24-26, and 29-31 stand rejected under 35 U.S.C. § 101.

Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,957,199 B1 to Fisher (“*Fisher*”) in view of U.S. Patent No. 6,347,307 to Sandhu et al. (“*Sandhu*”).

Claims 4, 5, 14, 15, 24, and 25 stand rejected under 35 U.S.C. § 103(a) over *Fisher* in view of *Sandhu*, and in further view of U.S. Publication No. 2002/0040352 to McCormick (“*McCormick*”).

Applicants respectfully submit that all of Applicants arguments and amendments are without *prejudice* or *disclaimer*. In addition, Applicants have merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicants reserve the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicants further respectfully submit that by not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are considered sufficient to overcome the Examiner's rejections. In addition, Applicants reserve the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

**REJECTION UNDER 35 U.S.C. § 112:**

Claims 1-31 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as their

invention. Applicants respectfully disagree and respectfully traverse the Examiner's rejection of Claims 1-31 under 35 U.S.C. § 112, second paragraph.

Applicants note that the Examiner's rejection of Claims 1-31 under 35 U.S.C. § 112, second paragraph in the present Office Action are ***mostly identical*** with the Examiner's rejection of Claims 1-31 under 35 U.S.C. § 112, second paragraph in the previous Office Action. Applicants are uncertain to what extent Applicants arguments in response to the Examiner's rejection of Claims 1-31 under 35 U.S.C. § 112, second paragraph in Applicants response dated 10 June 2008 have been fully considered or even considered. Applicants reiterate herewith Applicants arguments in response to the Examiner's rejection of Claims 1-31 under 35 U.S.C. § 112, second paragraph as set forth in Applicants response dated 10 June 2008. ***Applicants respectfully request the Examiner to fully consider Applicants arguments as set forth below.***

In particular, the Examiner states:

Regarding claims 1-31, the phrase "meta-model elements" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). ***The applicant appears to define a meta-model to be a trading partner agreement.*** It is unclear to what the applicant defines as the specific "elements" of the meta-model. The repetitious use of the term meta-model to define different aspects of meta-models is vague and does not make clear to the examiner what the applicant specifically defines the claimed invention to be. And how do these elements describe a portion of a potential standard for collaboration? Thus a broad interpretation to the phrase meta-model is applied.

(31 December 2007 Final Office Action, page 8 and 29 August 2008 Office Action, pages 2-3). (Emphasis added). With respect to the Examiner's assertion that the "[A]***applicant appears to define a meta-model to be a trading partner agreement***", Applicants respectfully disagree. In fact, Applicants respectfully direct the Examiner's attention to Applicants specification:

***A meta-model is a description of a [trading partner agreement] TPA that software, such as collaboration software 16, can read and understand.*** A meta-model may contain XML data or any other suitable type of software-readable data, depending on the implementation.

(Specification, Page 7, Lines 13-15). (Emphasis added). By contrast, Applicants respectfully submit that the term "***meta-model***," as shown above, is clearly defined in Applicants specification.

In particular, as clearly shown above, Applicants specification recites that a “*meta-model*” is a “*description of a [trading partner agreement] TPA*”, as opposed to *being* a TPA, as asserted by the Examiner. Furthermore, not only is the term “*meta-model*” clearly defined in the specification, its relationship to software (such as collaboration software 16) is likewise clearly described. Specifically, as shown above, a “*meta-model*” may “contain XML data or any other suitable type of software-readable data” and, in any event, is a “*description of a [trading partner agreement] TPA that software, such as collaboration software 16, can read and understand.*” Therefore, as is set forth in more detail herein, the term “*meta-model*” is defined with such specificity as to render definite Applicants claims within the meaning of 35 U.S.C. § 112, second paragraph.

In addition to the above-cited passage from Applicants specification, the term “*meta-model*”, Applicants respectfully direct the Examiner’s attention to Page 9 of Applicants specification which describes the *formulation* of a “*meta-model*”:

Through MMNS 18, enterprises 12 and 12f negotiate *one or more meta-model elements that will be used to formulate a meta-model describing a negotiated TPA* customized for their needs and suitable for their future collaboration.

(Specification, Page 9, Lines 19-22). (Emphasis Added). Therefore, a “*meta-model*” itself is formulated via “one or more *meta-model* elements,” which are defined at length in Applicants specification. In particular, Applicants respectfully direct the Examiner’s attention to Page 10, lines 4-6 of Applicants specification which sets forth a definition of a “*meta-model* element”:

*each meta-model element* typically deals with an associated set of *potential terms, definitions, or standards that may collectively provide a complete description of a negotiated TPA.*

(Specification, Page 10, Lines 4-6). (Emphasis Added). Accordingly, in light of the foregoing cited passages it is clear that Applicants have clearly, concisely and fully defined the term “*meta-model*” and “*meta-model* element”, in numerous places in Applicants specification. More particularly, the term “*meta-model*” and “*meta-model* element” is defined with such specificity as to clearly render definite, Applicants claims.

Once again, Applicants have clearly defined what a “*meta-model*” is (“a *description* of a TPA”), its *relationship* with software (software can read and understand); Applicants have further clearly described the particular manner in which a “*meta-model*” is *formulated* (*meta-model* elements), as well as defining “*meta-model* elements” themselves. Therefore, as evidenced by the above-cited passages, Applicants fully described and defined the term “*meta-model*” and “*meta-model* element” sufficiently as to clearly render definite Applicants claims.

It is well-established that claims must be given their “broadest reasonable interpretation” in light of the specification. (see MPEP §2111). Specifically, an Examiner must interpret “verbiage of the proposed claims [in] the broadest reasonable meaning in their ordinary usage as they would be understood by one of ordinary skill in the art, *taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.*” (MPEP 2111, citing *In re Morris*, 127 F. 3d. 1048, 1054-55, 44 USPQ2d 1023, 1027-27 (Fed. Cir. 1997)). As noted above, the term “*meta-model*” and “*meta-model* element” is clearly defined and described in numerous places Applicants specification. Thus, Applicants respectfully submit that the Examiner’s construction of the term “*meta-model*” and “*meta-model* element” in a manner inconsistent with Appellants’ specification is in clear and plain error.

### **The Examiner Improperly Asserts a Definition of the term ‘Meta-Model’**

In particular, the Examiner states:

*The examiner asserted a definition to the phrase “meta-model” to be a “trading partner agreement” for examination purposes.* A complete examination of a patent cannot be done without a clear definition of the terms used in the application. The definition asserted by the examiner is based on a broadest reasonable interpretation. The examiner is not saying the invention has to be specifically a trading partner agreement. The examiner said that the applicant “appeared” to use “meta-model” to mean a trading partner agreement. The purpose of stating that it was viewed as a trading partner agreement was to show how the claims were being interpreted by the examiner. Based on how a “meta-model” is defined in the specification and in the claims the examiner asserted that this “meta-model” could be a trading partner agreement. The applicant even argues “a meta-model element containing at least the further limitation ‘each capable of being negotiated by two or more enterprises and incorporated into a negotiated meta-

model” is supported by the specification. A trading partner agreement element can be negotiated by two or more enterprises and incorporated into a negotiated trading partner agreement. On page 17 of the amendment the applicant states that “the Examiner's construction of the term 'meta-model' fails to account for significant aspects of Applicants 'meta-model' as set forth in the specification.” *The applicant fails to disclose which portions of the “meta-model” as set forth by the specification negate the assertion of a trading partner agreement. The applicant fails to specifically mention one limitation of a “meta-model” that causes a trading partner agreement to not be a “meta-model.”*

(31 December 2007 Final Office Action, Pages 3-4). (Emphasis added). Applicants respectfully disagree and respectfully direct the Examiner’s attention to Applicants specification:

*A meta-model is a description of a [trading partner agreement] TPA that software, such as collaboration software 16, can read and understand. A meta-model may contain XML data or any other suitable type of software-readable data, depending on the implementation.*

(Specification, Page 7, Lines 13-15). (Emphasis added). Again, Applicants respectfully submit that the Examiner has mischaracterized the term “*meta-model*” and Applicants definition, thereof. For example, as noted above, the Examiner asserts that the “*examiner asserted a definition to the phrase “meta-model” to be a “trading partner agreement” for examination purposes*” and that the “*applicant fails to disclose which portions of the “meta-model” as set forth by the specification negate the assertion of a trading partner agreement*”. (31 December 2007 Final Office Action, Page 3). However, as clearly shown by the above-cited portion of Applicants specification a “*meta-model is a description of a [trading partner agreement] TPA that software, such as collaboration software 16, can read and understand*”.

For example, Applicants respectfully submit that, it is improper for the Examiner to assert a definition of the term “*meta-model*” when that term, as noted above, is clearly, concisely and fully defined in Applicants specification. Applicants respectfully request clarification as to why the Examiner would proffer a definition of a term *sua sponte* when exhaustive definitions for that term were already set forth at length in Applicants specification (as clearly shown above).

In addition to the fact that the Examiner has improperly asserted a definition of the term “*meta-model*”, when a clear definition is provided by Applicants specification, the Examiner asserts

a definition of the term “*meta-model*” that does not comport with, and in fact, directly contradicts, the thorough and careful definition provided by Applicants specification.

As noted above, and notwithstanding the Examiner’s assertion, Applicants specification makes clear that a “*meta-model is a description of a [trading partner agreement] TPA that software, such as collaboration software 16, can read and understand*”. Nevertheless, the Examiner asserts a “definition to the phrase ‘*meta-model*’ to be a ‘*trading partner agreement*’ for examination purposes.” (31 December 2007 Final Office Action, Pages 3-4). (Emphasis added). Applicants respectfully submit that this equation is inaccurate, that is the “*meta-model*” as asserted by the Examiner, does not equate to a “*trading partner agreement*”, as recited in independent Claim 1, because, among other things, Applicants specification makes clear that a “*meta-model is a description of a [trading partner agreement] TPA that software, such as collaboration software 16, can read and understand*”.

Furthermore, as can be seen from a comparison of Applicants *actual* definition of the term “*meta-model*,” as set forth in their specification, and the definition asserted by the Examiner, there is simply no equation between a “*description of a [trading partner agreement] TPA*” and a “*TPA*” itself. For example, the “*meta-model*” described and defined by Applicants specification relates to a “*description of a [trading partner agreement] TPA*” rather than a TPA itself. It is clear that there is simply no equivalence between a “*description*” of something and the thing itself. For example, one cannot properly argue that a “*description*” of a contract is equivalent to a “contract” itself. After all, while a contract itself is capable of being legally executed and enforced, a mere *description* of the contract may not. Similarly, there is simply no equation between the definition of *meta-model* set forth by Applicants as a “*description of a TPA*,” and the definition of “*meta-model*” by the Examiner as a “TPA” itself. In particular, in contrast to the Examiner’s asserted definition of a “*meta-model*” as *being* a “TPA,” or the thing itself, Applicants definition of “*meta-model*” relates to a “*description of a [trading partner agreement] TPA*” or a “*description*” of a TPA. Therefore, Applicants respectfully submit that the Examiner’s asserted definition of the term “*meta-model*” is clearly improper and simply does not make sense in light of the clear descriptions contained in Applicants specification.

Thus, Applicants respectfully submit that the Examiner has improperly crafted a definition of the term “*meta-model*” despite there existing clear support for the term in Applicants’ specification. As shown by comparison above, Applicants respectfully submit that the Examiner’s construction of the term “*meta-model*” fails to account for significant aspects of Applicants’ “*meta-model*” as set forth in Applicants specification. Accordingly, Applicants respectfully submit that the Examiner’s asserted definition of “*meta-model*” is improper in light of the clear definition provided for the term “*meta-model*” in Applicants specification.

**The Definition of ‘Meta-Model,’ as Set Forth in Applicants Specification, Negates the Examiner’s Assertion of ‘Meta-Model’ as a Trading Partner Agreement**

In particular, as discussed above, the Examiner states:

*The applicant fails to disclose which portions of the “meta-model” as set forth by the specification negate the assertion of a trading partner agreement. The applicant fails to specifically mention one limitation of a “meta-model” that causes a trading partner agreement to not be a “meta-model.”*

(31 December 2007 Final Office Action, Pages 3-4). (Emphasis added). Applicants respectfully disagree and respectfully direct the Examiner’s attention to Applicants specification:

*A meta-model is a description of a [trading partner agreement] TPA that software, such as collaboration software 16, can read and understand. A meta-model may contain XML data or any other suitable type of software-readable data, depending on the implementation.*

(Specification, Page 7, Lines 13-15). (Emphasis added). However, contrary to the Examiner’s assertion, there does exist at least “one limitation of ‘*meta-model*’ that causes a trading partner agreement to not be a ‘*meta-model*.’” (31 December 2007 Final Office Action, Page 3-4). First, the Examiner asserts that “the applicant fails to disclose which portions of the ‘*meta-model*’ as set forth by the specification negate the assertion of a trading partner agreement.” Applicants respectfully submit that the portion of the definition of a “*meta-model*” as a “description of a [trading partner agreement] TPA” (as opposed to actually being a TPA) alone is sufficient to negate the Examiner’s assertion of a “*meta-model*” as a “*trading partner agreement*”. (31 December 2007 Final Office Action, Page 3-4). In particular, the existence of a “*meta-model*” as a

“description” of a trading partner agreement (TPA) plainly negates the assertion that a *“meta-model” is a “trading partner agreement”*. Once again, a description of something is not equivalent to the thing itself. This clear fact alone negates the Examiner’s assertion that a *“meta-model” is a “trading partner agreement”*.

In addition to the foregoing, the Examiner asserts that *“the applicant fails to specifically mention one limitation of ‘meta-model’ that causes a trading partner agreement to not be a ‘meta-model.’”* (31 December 2007 Final Office Action, Page 3-4). Applicants respectfully submit that, as set forth in Applicants specification, a *“trading partner agreement” (“TPA”)* relates to the “negotiated standard” between “two or more enterprises.” (Specification, Page 7, Lines 7-9). Accordingly, while a *“trading partner agreement”* relates to the actual “negotiated standard,” a *“meta-model”* relates at least to a “description of a [trading partner agreement] TPA” or a description of a “negotiated standard.”

Thus, the fact that a trading partner agreement” pertains to the actual “negotiated standard” whereas a *“meta-model”* relates at least to a “description” of a “negotiated standard,” demonstrates “one limitation of *‘meta-model’* that causes a trading partner agreement to not be a *‘meta-model.’*” (31 December 2007 Final Office Action, Page 3-4). (Emphasis Added).

#### **Each Instance of the Term ‘Meta-Model’ in Applicants Claims is Clearly Defined**

In particular, the Examiner states:

The repetitious use of the term *meta-model* to define different aspects of *meta-models* is vague and does not make clear to the examiner what the applicant specifically defines the claimed invention to be.

(31 December 2007 Final Office Action, Page 8). (Emphasis added). Notwithstanding the Examiner’s assertion, Applicants respectfully submit that the relationship between each and every instance of the term *“meta-model”*, in Applicants claims are clearly defined, at least in the specification, as well as, being clear in Applicants claims themselves. Applicants respectfully submit that, beyond making a generalized conclusion, the Examiner does not set forth *any* reasoning to indicate why it is believed that the clearly defined use of the term *“meta-model”* point is



considered “vague and does not make clear to the examiner what the applicant specifically defines the claimed invention to be.”

Once again, as noted above, Applicants have clearly defined what a “*meta-model*” is, that is, a “*description of a [trading partner agreement] TPA.*” Applicants have likewise defined the *relationship* of a “*meta-model*” to software (software can read and understand the *meta-model description*). In addition, Applicants have further clearly described the particular manner in which a “*meta-model*” is *formulated*, in particular *via* “*meta-model* elements”. Moreover, Applicants have defined “*meta-model* elements” themselves as “each *meta-model* element typically deals with an associated set of potential terms, definitions, or standards that may collectively provide a complete *description* of a negotiated [trading partner agreement] TPA.” Accordingly, in light of the clear manner in which “*meta-models*” have been defined by Applicants specification, and in further light of the fact that “*meta-models*” relationships to other components have been described, the reason for the Examiner’s misunderstanding is unclear.

The term “*meta-model* element,” as noted above, is defined at least in Applicant’s specification at Page 10, Lines 4-6. Accordingly, since the term “*meta-model* element” is clearly defined in Applicants specification, and since the language of Applicants Claim 1 at least parallels the term “*meta-model* element” as defined in Applicants specification, the Examiner’s lack of clarity with regard to the use of this term is unexplainable. Accordingly, Applicants respectfully submit that the meaning of the term “*meta-model* element” is clear in light of Applicants specification.

Likewise, the meaning of the term “negotiated *meta-model*” is clearly defined in Applicants specification, at least in Applicants Specification at Page 11, Lines 9-10. In addition, a “negotiated *meta-model*” is illustrated at least in Figure 4 of Applicants specification. Thus, since the term “negotiated *meta-model*” is clearly defined by Applicants specification, and since a “negotiated *meta-model*” in relation to other elements is disclosed at least in Figure 4 of Applicants specification, the Examiner’s lack of understanding with regard to the use of this term is unexplainable. Ultimately, Applicants respectfully submit that the meaning of the term “negotiated *meta-model*” is clear in light of Applicants’ specification.

In addition to the foregoing, the meaning of the term “*meta-model* negotiation service” is clearly defined. Specifically, the term “*meta-model* negotiation service” is defined at least in Applicants specification at Page 7, Lines 18-27. Since the term “*meta-model* negotiation service” is clearly defined by Applicants specification, and since the language of Applicants Claim 1 uses at least the term “*meta-model* negotiation service” as defined at least in Applicants specification, Applicants respectfully submit that the meaning of the term “*meta-model* negotiation service” is abundantly clear in light of Applicants specification and claims.

Thus, for at least, the reasons set forth above, Applicants respectfully submit that the rejection of Claims 1-31 under 35 U.S.C. § 112, second paragraph, is improper and must be withdrawn.

**REJECTION UNDER 35 U.S.C. § 101:**

Claims 1, 4-6, 9-11, 14-16, 19-21, 24-26, and 29-31 stand rejected under 35 U.S.C. § 101.

Although Applicants believe Claims 1, 4-6, 9-11, 14-16, 19-21, 24-26, and 29-31 are directed to patentable subject matter without amendment, Applicants claim to further clarify that these claims are directed to patentable subject matter. These amendments are not considered narrowing or necessary for patentability. By making these amendments, Applicants do not indicate agreement with or acquiescence to the Examiner’s position with respect to the rejections of these claims under 35 U.S.C. § 101, as set forth in the Office Action.

For at least these reasons, Applicant respectfully submits that Claims 1, 4-6, 9-11, 14-16, 19-21, 24-26, and 29-31 are directed to statutory subject matter. Applicants further respectfully submit that Claims 1, 4-6, 9-11, 14-16, 19-21, 24-26, and 29-31 are in condition for allowance. Therefore, Applicants respectfully request that the rejection of Claims 1, 4-6, 9-11, 14-16, 19-21, 24-26, and 29-31 under 35 U.S.C. § 101 be reconsidered and that Claims 1, 4-6, 9-11, 14-16, 19-21, 24-26, and 29-31 be allowed.

## **REJECTION UNDER 35 U.S.C. § 103(a)**

Claims 1-3, 6-10, 11-13, 16-20, 21-23, and 26-31 stand rejected under 35 U.S.C. § 103(a) under *Fisher* in view of *Sandhu*. Claims 4, 5, 14, 15, 24, and 25 stand rejected under 35 U.S.C. § 103(a) over *Fisher* in view of *Sandhu*, and in further view of *McCormick*.

Applicants respectfully submit that the *amendments to Applicants claims have rendered moot the Examiner's rejection of these claims and the Examiner's arguments in support of the rejection of these claims*. Applicants further respectfully submit that Applicants amended claims in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Fisher*, *Sandhu*, and *McCormick*, either individually or in combination. Thus, Applicants respectfully traverse the Examiner's obvious rejection of Claims 1-31 under 35 U.S.C. § 103(a) over the proposed combination of *Fisher*, *Sandhu*, and *McCormick*, either individually or in combination.

### **The Proposed *Fisher-Sandhu* Combination is Improper Under MPEP § 706.02(j) For Applicants Claims**

Applicants respectfully submit that the rejection of Applicants Claims are improper under 35 U.S.C. § 103(a) over *Fisher* in view of *Sandhu*, because the Examiner's initial burden of proof has not been satisfied. In addition, Applicants respectfully traverse the rejection of Applicants Claims because the Examiner has not properly complied with MPEP § 706.02(j).

After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with *reference to the relevant column or page number(s) and line number(s) where appropriate*,

(B) the difference or *differences in the claim over the applied reference(s)*,

(C) the *proposed modification of the applied reference(s)* necessary to arrive at the claimed subject matter, and

(D) an *explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification*. (MPEP § 706.02(j)). (Emphasis Added).

With respect to the subject Application, Applicants respectfully submit that the Examiner has not set forth: (1) the relevant teachings of *Fisher*, even though the Examiner has set forth column and line numbers, the mere reference to for example, “(col. 4, line 39- col. 12, line 16)” does not provide Applicants with a reference to any particular relevant column and line number of *Fisher*, but is *merely a citation of nine (9) columns of Fisher, without providing any relevancy to the cited nine (9) columns of Fisher* (29 August 2008 Office Action, page 5); (2) any arguments or remarks regarding the differences in Applicants claims over *Fisher*, that is the *mere allegation that “Fisher teaches” then asserting Applicants claim limitations is clearly not an argument or remarks regarding the differences in Applicants claims over Fisher* (29 August 2008 Office Action, page 5); (3) asserted any proposed modifications of *Fisher* to arrive at Applicants claimed invention, as noted above, the Examiner merely asserts that “*Fisher teaches” then the Examiner merely recites Applicants claim limitations, which clearly does not propose any modification of Fisher to arrive at Applicants claimed invention*; or (4) any explanation why one of ordinary skill would have been motivated to make the proposed modifications.

In addition to failing to comply with the above MPEP requirements, the Examiner has also failed to establish a *prima facie* case of obviousness based on the three basic requirements set forth in MPEP § 706.02(j). First, there must be some suggestion or motivation, either in *Fisher* or *Sandhu*, or in the knowledge generally available to one of ordinary skill in the art, to modify *Fisher* and *Sandhu*. Second, there must be a reasonable expectation of success. Finally, *Fisher* and *Sandhu*, either individually or in combination, must teach or suggest all Applicants claim limitations. *The teaching or suggestion to make the proposed Fisher and Sandhu combination and the reasonable expectation of success must both be found in Fisher or Sandhu and not based on Applicants disclosure. In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis Added).

Applicants still further respectfully submit that the MPEP clearly states that the “initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done.” (MPEP § 706.02(j)). “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the

artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). In the subject Application, the Examiner has not shown Applicants claimed invention to be expressly or impliedly suggested in the *Fisher* or *Sandhu* reference nor has the Examiner presented a convincing line of reasoning, let alone any reasoning, why the artisan would have found Applicants claimed invention to be obvious in view of *Fisher* or *Sandhu*.

The MPEP further states that “it is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” (MPEP § 706.02(j)). Thus, if the Examiner continues to maintain the rejection to Claims 1-31 under 35 U.S.C. § 103(a) based on the proposed combination of *Fisher* and *Sandhu*, Applicants respectfully request that the Examiner provide a proper argument in support of the Examiner’s rejection, as necessitated by MPEP § 706.02(j).

For at least the reasons set forth herein, Applicants respectfully request that the rejection of Claims 1-31 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-31 be allowed.

**The Office Action Fails to Properly Establish a *Prima Facie* case of Obviousness over the Proposed *Fisher-Sandhu* Combination According to the UPSTO Examination Guidelines**

Applicants respectfully submit that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Fisher* or *Sandhu*, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “**ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.**” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “**factual findings made by Office personnel are the necessary underpinnings to establish obviousness.**” (*id.*). Further, “**Office personnel must provide an explanation to support an obviousness rejection** under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject Application, the Office Action has not shown the **factual findings necessary to establish obviousness** or even **an explanation to support the obviousness rejection** based on the proposed combination of *Fisher* and *Sandhu*, either individually or in combination. The Office Action merely states that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Fisher* to include the details of *Sandhu* because both inventions teach conducting Internet financial transactions specifically the business activity of trading.” (29 August 2008 Office Action, pages 6-7). Applicants respectfully disagree and respectfully submit that the Examiner’s conclusory statement is not sufficient to establish the **factual findings necessary to establish obviousness** and is not a sufficient **explanation to support the obviousness rejection** based on the proposed combination of *Fisher* and *Sandhu*. **Applicants respectfully request that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including the factual findings necessary to**

*establish obviousness to “ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “***obviousness rejection should include***, either explicitly or implicitly in view of the prior art applied, ***an indication of the level of ordinary skill.***” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided ***an indication of the level of ordinary skill.*** ***Applicants respectfully request that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an indication of the level of ordinary skill, relied upon by the Examiner.*** (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that ***Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.*** (*Id.*). In addition, the Guidelines state that the proper analysis is ***whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.*** (*Id.* and See 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicants invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to ***explain whatsoever why the difference(s) between the proposed combination of Fisher and Sandhu, either individually or in combination and Applicants claimed invention would have been obvious to one of ordinary skill in the art.*** The Office Action merely states that “[i]t is believed that based on the broadest

reasonable interpretation [of] the claims that both pieces of art speak on the claimed invention.” (29 August 2008 Office Action, pages 6-7) Applicants respectfully disagree and further respectfully request clarification as to *why the difference(s) between the proposed combination of Fisher and Sandhu, either individually or in combination, and Applicants claimed invention would have been obvious to one of ordinary skill in the art.* Applicants further respectfully submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the “key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that “*the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.*” (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that “[R]ejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there *must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” (*KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.



Applicants respectfully submit that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicants claimed invention would have been obvious*. For example, the *Examiner has not adequately supported the selection and combination of Fisher and Sandhu, to render obvious Applicants claimed invention*. The Examiner's unsupported conclusory statements that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to modify Fisher to include the details of Sandhu because both inventions teach conducting Internet financial transactions specifically the business activity of trading” and “[i]t is believed that based on the broadest reasonable interpretation [of] the claims that both pieces of art speak on the claimed invention,” *does not adequately provide clear articulation of the reasons why Applicants claimed invention would have been obvious*. (29 August 2008 Office Action, pages 6-7). In addition, the Examiner’s unsupported conclusory statement fails to meet any of the Guidelines’ rationales to render obvious Applicants claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *Fisher* and *Sandhu*, *Applicants respectfully request that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines*.

#### **Applicants Claims are Patentable over the Proposed *Fisher-Sandhu-McCormick* Combination**

Applicants respectfully submit that, as discussed above, independent Claims 1, 11, 21, and 31 are considered patentably distinguishable over the proposed combination of *Fisher*, *Sandhu*, or *McCormick*.

Furthermore, with respect to dependent Claims 2-10, 12-20, and 22-30: Claims 2-10 depend from independent Claim 1; Claims 12-20 depend from independent Claim 11; and Claims 22-30 depend from independent Claim 21. As mentioned above, each of independent Claims 1, 11, 21, and 31 are considered patentably distinguishable over the proposed combination of *Fisher*, *Sandhu*, or *McCormick*. Thus, dependent Claims 4, 5, 14, 15, 24, and 25 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, Applicants respectfully submit that Claims 1-31 are not rendered obvious by the proposed combination of *Fisher*, *Sandhu*, or *McCormick*. Applicants further respectfully submit that Claims 1-31 are in condition for allowance. Thus, Applicants respectfully request that the rejection of Claims 1-31 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-31 be allowed.

**CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

30 November 2008  
Date

/Steven J. Laureanti/signed  
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